

REMARKS

Applicants acknowledge receipt of a final Office Action dated October 23, 2009. Claims 1-7 and 9-20 remain pending in the application. In this action, claims 1 and 13 are amended. Claims 5, 6 and 9 are cancelled. No new matter is being added.

After entry of these amendments, therefore, claims 1-4, 7, and 10-20 are pending and are being presented for examination.

I. STATEMENT OF SUBSTANCE OF INTERVIEW

Applicants thank Examiner L. Soroush and Supervisory Patent Examiner S. Padmanabhan for extending the courtesy of a telephone interview on February 23, 2010. During that interview, the examiners acknowledged that there was a distinction between “water repellency” and “water runability” and that the data in the 132 declaration of record provided support for improved water runability, which was an unexpected property of the claimed composition.

The substance of the interview is further set forth in more detail below.

II. CLAIM 1 AS AMENDED IS NONOBVIOUS

On page 3 of the Office Action, the PTO has rejected claims 1, 3-7, 9-10, 12, 14-16 and 18-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over WO 02/03928 to Ichinohe *et al.* (hereafter “Ichinohe”) in view of U.S. Patent 4,892,726 to Yonekura *et al.* (hereafter “Yonekura”), JP 2000-309505 to Oka *et al.* (hereafter “Oka”) and U.S. Patent 6,534,044 to Wada *et al.* (hereafter “Wada”).

Applicants respectfully traverses the rejection for the reasons set forth below.

A. Claim 1 As Amended Is Commensurate in Scope

As explained below, the PTO has not made out a *prima facie* case of obviousness against the claims as amended. Nevertheless, even if such a *prima facie* case were properly

made out, the unexpected results in the declaration of record would clearly establish non-obviousness.

The data in the declaration is fully commensurate in scope with the claims as amended. The declaration provides test data showing unexpected results for components (A), (B), (C), (D), and (E), i.e., **each and every claimed component of the invention.**

For example, as described in Example A and Comparative Examples A and B in Table 1 of the Ishii declaration of record, when the weight percent of component (E), an octylsilylated fine particle zinc oxide, (“an organosilane” treated pigment) was changed to a value outside of the defined range for the claimed composition (i.e., 12-30% by weight), the resultant compositions showed no water-runability. Thus, in comparative Example A, where the weight percent of component (E) is decreased to a value outside the claimed range (8% by weight), the resultant composition showed no water runability. Much in the same manner, increasing the weight percent of component (E) to 38% by weight as disclosed in comparative Example B, also results in a composition that has no water-runability. Example 1 that is formulated according to the present invention, however, showed an excellent performance in water-runability.

Also, the declaration provides similar test data showing good water runability for Examples with components (A), (B), (C), and (D) within the claimed ranges, and no water runability for Comparative Examples with components (A), (B), (C), and (D) outside the claimed ranges, respectively. These have been explained previously in great detail.

Accordingly, based on the test data, the claimed composition is patentable over the cited art.

Moreover, as explained below, no *prima facie* case has been made by the PTO.

B. No Prima Facie Case Has Been Made Out

Independent claim 1 recites a cosmetic composition that comprises specific amounts of five components, namely, (a) a non-volatile oil agent, (b) a water repellent resin powder, (c) an oil soluble silicone resin, (d) volatile solvent excluding water, (e) a water repellent

surface treated pigment. This particular combination of components provides a composition that has the unexpected property of good water runability, that is, there is no temperature dependence on the water-runability of the claimed composition.

None of the cited art teach or suggest a composition that has the recited components in the ranges claimed. Neither do the cited references teach or suggest the disclosed compositions to possess good water runability or discuss the impact of temperature on water-runability. Applicants submit that the PTO is attempting to pick and choose bits and pieces from numerous references to arrive at the claimed composition. This amounts to nothing more than an impermissible hindsight reconstruction of Applicants' claimed invention.

Ichinohe is cited to teach components (A), (C), (D) and the use of polymethylsilsesquioxane as an organic powder. Ichinohe is focused on a cosmetic material that contains a silicone modified wax that is obtained by esterifying polypropylene with silicone. See abstract. More specifically, Ichinohe is concerned with a cosmetic material in which the wax specified above is incorporated to impart thereto a good spread capability, high possibility of giving a feeling of refreshment to users and strong repellencies to sweat and water" (see paragraph 1 of Ichinohe). It is clear from this statement that Ichinohe is focused on "water-repellency" as would be expected, but pays no attention to either "water-runability" or "temperature dependency."

In Ichinohe, the silicone-modified wax defined in Claim 1 of Ichinohe is an essential component. Ichinohe also describes various materials other than the silicone-modified wax. Applicants submit, however, that the mere description of various components by Ichinohe would not have led a person skilled in the art to the presently claimed *combination* of specific components.

Although, it is the PTO's contention that example 11 of Ichinohe discloses components (A), (C), (D), the Office admits (page 4), that Ichinohe teaches a very broad range for the components of its composition, for example, a range from 0.1 – 99 weight percent and that this reference does not teach the other components of the claimed composition. For example, the cited example does not teach components B, or E and 1,3,

butylene glycol alluded to belong to the group component (D) of the presently claimed composition has a boiling point that falls outside the recited range (207 °C), for volatile solvents. Although, Ichinohe may disclose polymethylsilsesquioxane, this compound is disclosed amongst a laundry list of compounds being taught as suitable organic powders in the disclosed composition.

There is no reason that a person skilled in the art would in light of such a broad generic description, consider this reference for information to make a cosmetic composition as claimed.

Yonekura cited to remedy this deficiency discloses using the polymethylsilsesquioxane powder to improve the spreadability of the cosmetic composition Yonekura does not discuss “water-runability” or its “temperature dependency.” The advantageous effects discovered by Applicants cannot be obtained by using polymethylsilsesquioxane powders alone. It is necessary to formulate a specific *combination* of components, *i.e.* presently claimed components (A) to (E), in specific amounts to obtain the effects. A person skilled in the art would never conceive of such idea from Yonekura.

The PTO has suggested that Oka teaches hydrophobic agents such as fluorine-modified trimethylsiloxy silicate treated powders (see OA, page 5). However, Oka’s fluorine-modified trimethylsiloxy silicate treated powders are not disclosed as being oil-soluble resins, and, accordingly, are different from component(C) of the presently claimed invention.

Hougham is cited to teach that fluorination of polymer provides for a wide range of properties (see OA, page 5). However, Hougham does not recite water-runability and its temperature dependency as properties. Thus it is not clear what properties can be obtained by using Hougham’s fluorinated polymer.

Regarding component (D), claim 1 is now amended to recite the volatile solvent to be a low boiling solvent (boiling point 200 C or less at 1 atm), excluding water and selected from cyclic tetra- to hexamer of dimethylpolysiloxane, branched tetramer of dimethylpolysiloxane (methyl trimethicone), linear dimethylpolysiloxane and a lower alcohol. Ichinohe discloses cyclic siloxanes, for example, octa- and

decamethylcyclotetrasiloxane as examples of silicone oils used as unctuous agents with silicone modified wax of the disclosed compositions. Ichinohe does not teach cyclic tetrahexamer of dimethylpolysiloxane and none of the other references remedy this defect.

Accordingly, component (D) is not taught by the cited references.

The PTO cites Wada et al., to teach a silica coated metal oxide particle (component (E)), thus remedying the absence of a teaching in Ichinohe's Example 11 for a water repellent surface treated pigment. Example 11 of Ichinohe refers to a composition having pigments. This example does not specify an amount for the pigments in the disclosed composition, rather the amount is indicated as being "proper". Since the weight percentages for the other components already add up to 100.0%, it is clear that any amount of pigment must be at the trace level so as to avoid interfering with the specified relative proportions of the other components. Thus, Example 11 of Ichinohe fails to describe the presently claimed range of 12 to 30 % by weight.

The PTO cites col. 3, lines 39-47 and col. 49, claim 1 of Wada to teach silica coated metal oxide particles that are further coated with a hydrophobizing agent. Claim 1 is amended so component (E) now recites 12 to 30% by weight of one or more kinds of water-repellent surface treated pigments, wherein the water-repellent surface treated pigment is selected from pigments subjected to silane treatment with organosilane having an alkyl group with carbon numbers of 6 to 20 which may be substituted and a pigment subjected to silicone treatment. Wada does not teach component (E), contrary to the PTO's opinion. Wada teaches surface hydrophobization of metal oxide particles using a alkylalkoxysilane reagent that has C₁-C₃ carbons in the alkyl chain and C₁-C₄ carbons in the alkoxy chain. Moreover, the advantageous effects described in the present application cannot be obtained by using particles surface treated with a hydrophobizing agent alone. It is necessary to formulate specific *combination* of components, *i.e.* presently claimed components (A) to (E), in specific amounts to obtain the beneficial effects.

C. The Remaining Rejections Should Be Withdrawn

On page 9 of the Office Action, the PTO has rejected claims 2 and 17 under 35 U.S.C. §103(a) as allegedly being unpatentable over Ichinohe in view of Yonekura, Oka, and Wada, and further in view of JP 01211518 to Fukuchi (hereafter “Fukuchi”).

Claims 2 and 17 depend from patentable claim 1 and further recite specific embodiments of the claimed compositions. These claims are patentable over the cited art for at least the same reasons mentioned above for claim 1.

On page 11 of the Office Action, the PTO has rejected claims 11 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over Ichinohe, Yonekura, Oka, and Wada, and further in view of JP 2000327948 to Hayashi *et al.* (hereafter “Hayashi”)

Claims 11 and 13 depend from patentable claim 1 and incorporate all its limitations. Claim 13 recites that the water-repellent surface treatment of the pigment (component (E)), is done using octylsilane that is not disclosed in Wada. These claims are patentable, therefore, over the cited art.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 23-MAR-2010

By



FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5540
Facsimile: (202) 672-5399

Rouget F. Henschel
Registration No. 39,221